**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Application of: Darian A. Johnson | | | |
| Appln. No. | 10/796,761 | Art Unit: | 3724 |
| Filed: | March 9, 2004 | Examiner: | Boyer D. Ashley |
| For: | UTILITY KNIFE BLADE HAVING AN UNEVEN CUTTING EDGE | Docket No.: | 49/1284US |

Assistant Commissioner for Patents
Washington, D.C. 20231

## Declaration of Prior Invention in the United States to Overcome Cited Patent (37 C.F.R. §1.131)

Being of legal age, I, Darian A. Johnson, declare and state as follows:

1. This declaration is to establish that, in accord with 37 C.F.R. § 131, United States Patent No. 6,823,593, is unavailable for use as prior art during the examination of the above referenced patent application, U.S. Patent Application Serial No. 10/796,761.

2. In regard to an attempt to overcome various disadvantages of prior art utility knives and knife blades, I conceived of a knife blade, particularly beneficial for use in a standard utility knife, which blade is described and claimed in the present application. My conception included a knife that makes use of the blade, also as claimed in the present application.

3. After conception, and before February 18, 2003, I made at least one drawing, and additionally had at least one drawing made by a professional draftsperson, of an embodiment of my invention.

4. As evidence of my conception, examples of drawings of an embodiment of my invention made by me or a professional draftsperson are shown in Exhibits A and B. The dated drawings in Exhibits A and B were made prior to February 18, 2003. The dates on these drawings indicating their existence prior to February 18, 2003, have been redacted.

5. A description of documents in the attached exhibits follows.

Exhibit A - Shows a drawing I made of an embodiment of my invention on a date prior to February 18, 2003.

Exhibit B - Shows a professionally drafted drawing of an embodiment of my invention that was made on my behalf on a date prior to February 18, 2003.

6. Also after conception and before February 18, 2003, I engaged an attorney for the purpose of filing a patent application disclosing an invention embodying my conception for a knife and knife blade.

7. My attorney filed Provisional Patent Application Serial No. 60/453452, disclosing my invention, on March 10, 2003.

8. In the days between when my attorney initially took on responsibility for filing my provisional patent application and when it was filed, I believe my attorney worked reasonably hard, in the normal course of practice, reviewing information supplied to him regarding my invention, including drawings, such as those shown in Exhibits A and B, as well as drafting the specification and filing my provisional patent application, all with appropriate attentiveness given my attorney's workload at the time.

9. The present patent application, U.S. Patent Application Serial No. 10/796,761 was filed during the one-year pendency of my Provisional Patent Application Serial No. 60/453452, and properly claims the benefit thereof, thereby entitling the present application to the constructive reduction date of March 10, 2003. See included BPAI and MPEP references.

10. This declaration is submitted prior to a final rejection of the present application, U.S. Patent Application Serial No. 10/796,761.

11. I declare further that all statements made herein of my own knowledge, are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements and the like may jeopardize the validity of the application or any patent issuing thereon.

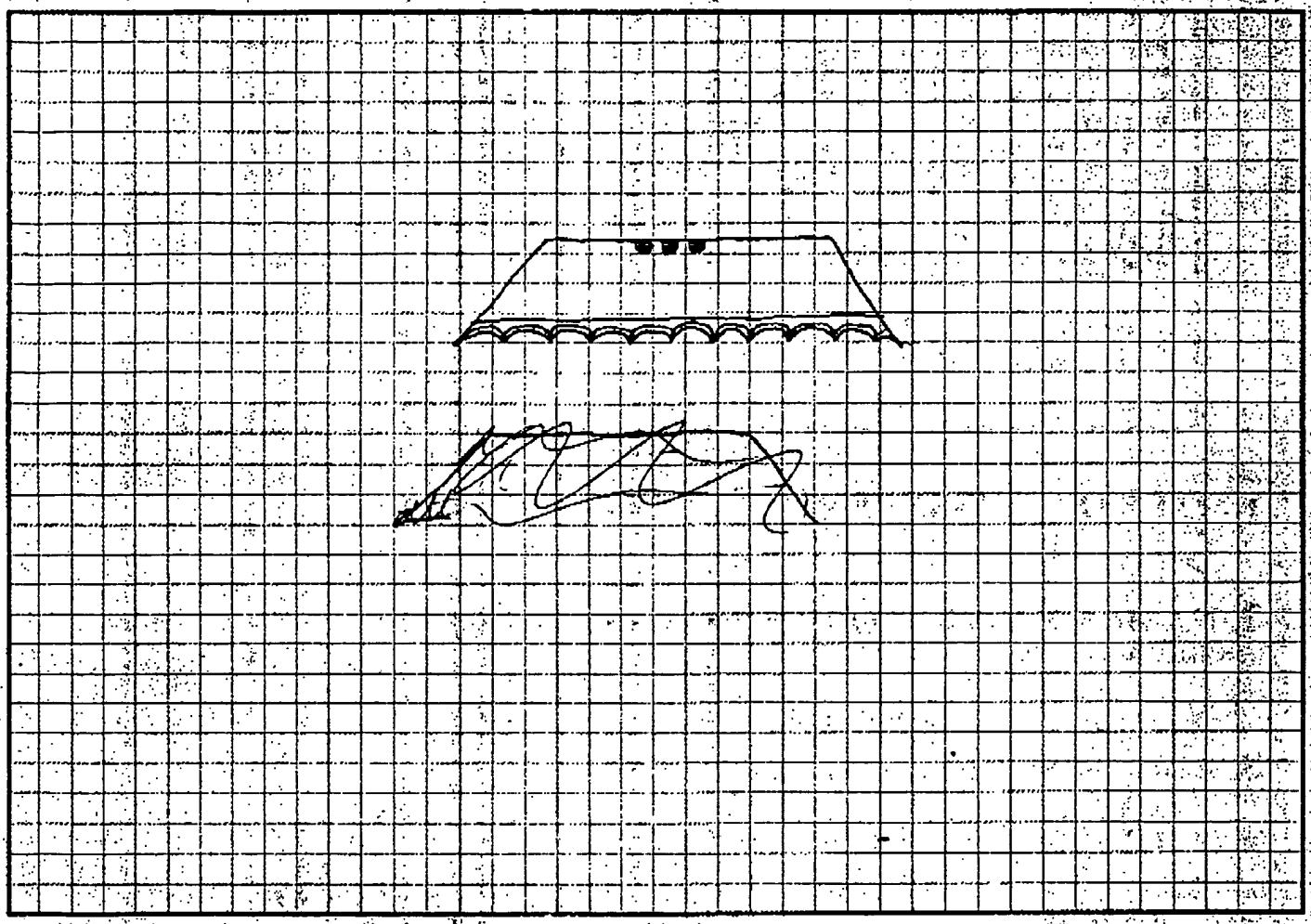
3-16-05
Date

Darian A. Johnson
Inventor of U.S. Patent App., Ser. No. 10/796,761

Exhibit A

# ILLUSTRATION

To the best of your ability, please sketch the major working parts of your idea or invention. If you have photos or mechanical drawings please attach copies of them to this sheet. Please do not submit a working model or other valuable original materials to us. Please use black ink. Do not use pencils.



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☐ A  Received Via: ☐ Mail ☐ Fax ☐ Internet ☐ Other

1. Approved: ☐ Rejected: ☐ Proceed with caution: ☐
2. Approved: ☐ Rejected: ☐ Proceed with caution: ☐
3. Approved: ☐ Rejected: ☐ Proceed with caution: ☐

Artwork: Missing: ☐ Insufficient: ☐ Incomplete: ☐

Disposition
Similar: ☐ ____
Poss. Des/Mech Flaw: ☐ ____
Insuff/needs add info: ☐ ____
Diff. to read: ☐ ____

Comments: _____

Trademark-Invention Title: OK: ☐ _____ Missing: ☐ _____ Needs Modification: ☐ _____

TM Comments: _____

Exhibit B

[redacted]



[redacted]

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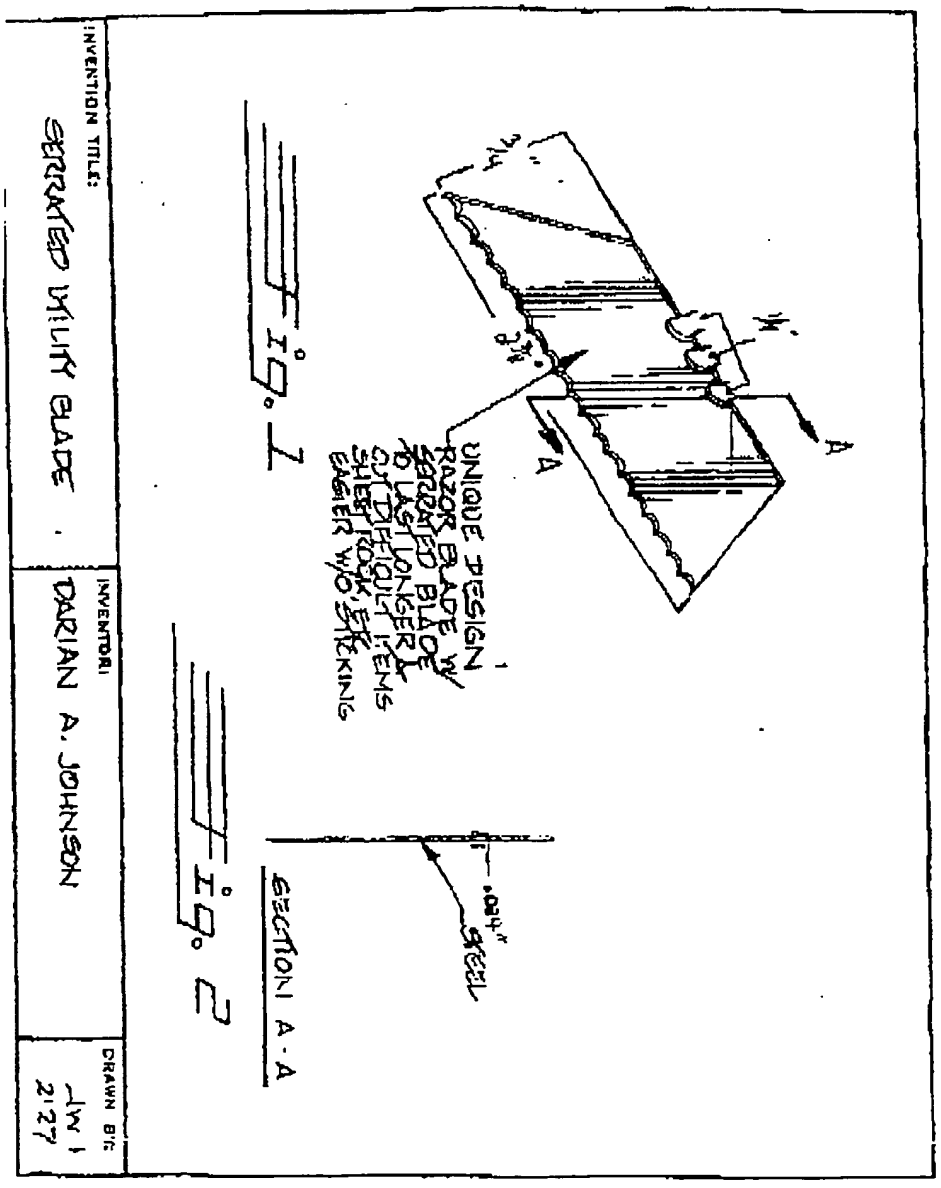

LEXSEE 27 USPQ2D(BNA) 1067

Ex parte et al.

Appeal No. 92-1168 from Art Unit 1805

Application for Patent filed Serial No. ; a Continuation of Serial No. filed , Abandoned. DNA Sequence Containing the DNA Sequence Coding for Human Tissue Plasminogen Activator Originating from Human Normal Cells, Recombinant DNA Incorporating the DNA Sequence, Host Cells Transformed with the Recombinant DNA, and Process for Producing Human Tissue Plasminogen Activator by Use of the Host Cells.

Board of Patent Appeals and Interferences

*1993 Pat. App. LEXIS 4; 27 U.S.P.Q.2D (BNA) 1067*

January 29, 1993, Decided

**[*1]**

Before Goldstein, Pellman and W. Smith, Examiners-in-Chief.

**COUNSEL:**

Supervisory Primary Examiner - Richard A. Schwartz.

Examiner - N. Treptow.

**OPINIONBY:** PELLMAN

**OPINION:**

Pellman, Examiner-in-Chief.

This is an appeal from the examiner's decision finally rejecting claims 1 through 5, all the claims in the application.

The subject matter on appeal involves a DNA sequence coding for human tissue plasminogen activator (t-PA) produced by human normal cells (claim 1). The invention also includes the specific DNA nucleotide sequence coding for said t-PA (claim 2), a vector capable of self replication and containing the DNA sequence of claim 1 (claim 3), a microbial or mammalian cell transformed with the recombinant DNA of claim 3 (claim 4) and a process for culturing the mammalian cell of claim 4 to produce human t-PA (claim 5). To exemplify the claims on appeal, claim 1, the only independent claim, is reproduced as follows:

1. A DNA sequence containing the DNA sequence coding for human tissue plasminogen activator produced by human normal cells.

To evidence the lack of patentability of the claimed invention, the reference upon which the examiner relies is identified as follows:

Goeddel et al. (Goeddel) 4,766,075 **[*2]** Aug. 23, 1988

All the claims stand rejected for being anticipated [*35 U.S.C. 102*(e)] by Goeddel. The examiner points out that the reference at Fig. 5C discloses the DNA sequence claimed by appellants herein in claim 1. Additionally, we are told, the

claimed sequence in claim 2 corresponds to that encoding amino acids -3 through 527 of the reference. The examiner further specifies the particular portions of the patent disclosing the features to which appellants' other claims are directed.

Contrariwise, appellants, beginning at page 3 of their brief, contend that Goeddel is not effective as a reference as of its filing date for the information upon which the examiner relies because the originally disclosed t-PA DNA base sequence, included in the application as filed, differs from that claimed in the issued patent. At page 4 of the brief, appellants present the following argument:

The Court of Customs and [sic] Appeals, predecessor to the Court of Appeals for the Federal Circuit, has held that only *actual matter contained in an issued patent* or fairly referenced and incorporated in an issued U.S. Patent, is citable as prior art as of either the filing date of the patent or **[*3]** one of its earlier, parent applications. The relevant case is *In re Lund, [376 F.2d 982] 153 USPQ 625* (CCPA [1967]).

*OPINION*

After giving due consideration to the arguments presented by appellants, as well as the opposing arguments advanced by the examiner, we are unpersuaded of reversible error in the rejection before us, which will be sustained. Since we are in substantial agreement with the examiner's reasoning, we incorporate by reference the explanation presented in the answer. We add the following comments to amplify the examiner's rationale.

In passing, we note that claims 1 and 2 contain no indication that the DNA sequence is either isolated or purified. Therefore, it appears that the DNA sequence to which these claims are directed does not distinguish from the naturally occurring substance. In this connection, compare the claim in the Goeddel patent of record. In the event of any further prosecution involving the present subject matter in this or a continuing application, care should be taken by appellants and the examiner to insure that the claims are limited to the specific subject matter appellants regard as their invention.

Returning to the rejection **[*4]** at hand, we observe that appellants, at page 8 of the brief, identify three changes in the DNA sequence that Goeddel is alleged to have made in the application corresponding to the patent cited by the examiner. Appellants state that at positions 722 and 761, G (Guanine) has been changed to A (Adenine) and at position 713, A has been changed to G. Appellants discuss sequences that were disclosed subsequent to the filing date of the Goeddel application and tabulate all the variations in the encoded sequences in Table I accompanying the brief.

Conversely, the examiner, at page 5 of the answer, contends there is only one difference between the coding sequence disclosed in the Goeddel application, as filed, and the final published patent. In this connection, the examiner invites attention to column 15 of said Table I. We are told that said difference consists of a change in base position 726 from A to C (Cytosine) in the issued patent. The examiner further explains that:

This difference leads to *no* change in the amino acid sequence. Although there are additional differences between the sequence disclosed in the Goeddel application as filed and the final published patent in **[*5]** the 5' and 3' non-coding regions, these regions are *not* present in the sequence claimed by the applicants, and have no effect on the operability of the sequence encoding human t-PA. The DNA sequence claimed by appellants (see claim 2, page 19 of the appeal brief) corresponds to that which codes for amino acids -3 to 527 of the t-PA protein, i.e. coding sequence only.

As is evident from the foregoing, appellants and the examiner agree that some change was made to the disclosure in the Goeddel application as filed. However, a change, per se, in an application disclosure does not constitute proscribed new matter. The question that first must be answered is whether the initial application provided by the patentee adequately enabled a person skilled in the subject art to practice the invention as claimed. On the record before us, we are convinced that Goeddel represents an effective reference under *35 U.S.C. 102*(e).

Goeddel is a domestic patent and, therefore, is imbued with a legal presumption of correctness under *35 U.S.C. 282*. See *In re Lamberti, 545 F.2d 747, 192 USPQ 278 (CCPA 1976); In re Weber, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969);* and *In re Jacobs, 318* **[*6]** *F.2d 743, 137 USPQ 888 (CCPA 1963).* Consequently, the examiner's citation and reliance upon the Goeddel patent shifted the burden of going forward to appellants, who, to overcome the rejection, were required to rebut the presumption of operability of the cited patent by a preponderance of the evidence. Compare *In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).* This, appellants have not done.

While the cited decisions refer to chemical compounds, rather than sequenced DNA, we stress that a gene is a chemical compound, albeit a complex one. See *Amgen Inc. v. Chugai Pharmaceutical Co., 927 F.2d 1200, 18 USPQ2d*

*1016 (Fed. Cir. 1991),* at *18 USPQ2d 1021.* Thus, it is manifest that the prior decisions involving chemical compounds are equally applicable to claims directed to the present subject matter.

Addressing the question of alleged new matter in the Goeddel application, we invite attention to the decision in *In re Nathan, 328 F.2d 1005, 140 USPQ 601 (CCPA 1964),* wherein the court, in the third paragraph from the end of its decision, holds as follows:

A subsequent clarification of or a change in an original disclosure does not necessarily make that original disclosure **[*7]** fatally defective. This court in *Reister v. Kendall, 34 CCPA 859, 159 F.2d 732, 72 USPQ 481,* dealt with an interference in which a count was directed to certain dyestuffs. Appellee relied on a British provisional specification for constructive reduction to practice although the structural formulae given for the identification of the respective products of the reaction in appellee's British specification *differed* from the corrected formulae for the same products recited in his U.S. application. The board nevertheless, in finding for appellee, held that his British specification disclosed the dyestuffs and the means for identifying them irrespective of the wrong formulae and thus was a sufficient disclosure of the patentable subject matter. This court found no error in the board's decision. *(140 USPQ 603-604)*

Also see the decision in *In re Magerlein, 346 F.2d 609, 145 USPQ 683 (CCPA 1965),* in which the court reached a similar conclusion, relying upon the *Nathan* decision.

Appellants have not apprised us of any objective evidence tending to establish that the Goeddel disclosure, as filed, was non-enabling, i.e., that the patent specification was insufficient to **[*8]** enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See *Amgen Inc. v. Chugai Pharmaceutical Co., supra,* and *In re Wands, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988).* In particular, see the *Wands* decision at *8 USPQ2d 1404,* wherein the court explains:

Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. "the key word is 'undue,' not 'experimentation.'"

The determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art . . . The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed * * *.

The court cited and relied upon the discussion in *Ex parte Jackson, 217 USPQ 804 (Bd.App. 1982),* at *217 USPQ 807.*

Parallel to the **[*9]** holding in the *Wands* decision, there was a high level of skill in this art at the time the application was filed and all the methods needed to practice the invention were well-known. Compare *In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988).* Since "routine experimentation" may involve rather extensive studies without straying from "undue" experimentation, and since appellants have provided no countervailing evidence to persuade us otherwise, we are satisfied that the changes in the application of the Goeddel patent were of the type condoned by the decisions in *In re Magerlian, supra,* and *In re Nathan, supra.*

Insofar as we can ascertain, for legal precedent, appellants rely only upon the decision in *In re Lund, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).* This decision is inapposite to the facts at hand. In the *Lund* decision, the court held that a "continuation-in-part" of a prior application is entitled to the filing date of the parent application as to all subject matter *carried over* into it from the parent application, whether for purposes of obtaining a patent or subsequently utilizing the *patent* disclosure as evidence to defeat another's **[*10]** right to a patent. The court further held that the mere characterization of the application as a continuation-in-part of a prior application subsequently abandoned, was not sufficient in and of itself to render Example 2 of the abandoned application part of the patent disclosure as if fully set out therein. Thus, the indicated example was not tacitly described in the patent within the meaning of Section 102(e).

Additionally, the court considered the question of whether the example in the abandoned application showed that the invention was *known* or used by others in this country before the invention thereof by the applicant for patent. The court pointed out that "knowledge" required by that provision of the statute to defeat another's patent rights has long been interpreted to mean *public* knowledge. Therefore, the example in the abandoned application was not the type of knowledge contemplated by the statute. Neither of the foregoing situations is germane to the facts of the present appeal.

Rather, see *Kennecott Corp. v. Kyocera International Inc., 835 F.2d 1419, 5 USPQ 1194 (Fed. Cir. 1987)* and *In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971),* both of which **[*11]** follow the reasoning in the *Nathan* and *Magerlein* opinions.

Revisiting the question of "new matter", we turn to the decision in *Ex parte Marsili, 214 USPQ 904 (Bd.App. 1979),* cited in the answer. In addition to the relevant decisions cited in the *Marsili* case, we stress the logic in the concluding paragraph of the Board's holding, regarding the basis for the policy permitting the change in Goeddel's application. Thus, as observed in the noted opinion:

To refuse correction of the structural formula of Appellants' claimed compounds, which have been found patentable by the Examiner, would lead to the absurdity of issuing a patent which teaches the public in its specification the wrong scientific formula for the new products. *(214 USPQ 906-907)*

The relevance of the above to the circumstances in the Goeddel patent are inescapable.

In view of our foregoing remarks, taken with the specific facts of the present appeal, we find that the examiner has a meritorious position. Since appellants have not informed us of any technical information or current patent jurisprudence inconsistent with the examiner's position, the rejection before us logically must be sustained.

For **[*12]** the reasons expressed in the answer and those discussed above, the examiner's decision rejecting claims 1 through 5 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, *54 F.R. 29548 (July 13, 1989), 1105 O.G. 5* (August 1, 1989).

*AFFIRMED*

undermines the specificity of the inventor's idea that it is not yet a definite and permanent reflection of the complete invention as it will be used in practice." *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1229, 32 USPQ2d 1915, 1920 (Fed. Cir. 1994).

### A PREVIOUSLY ABANDONED APPLICATION WHICH WAS NOT COPENDING WITH A SUBSEQUENT APPLICATION IS EVIDENCE ONLY OF CONCEPTION

An abandoned application with which no subsequent application was copending serves to abandon benefit of the application's filing as a constructive reduction to practice and the abandoned application is evidence only of conception. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

## 2138.05 "Reduction to Practice"

Reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the claimed invention is filed. The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. Thus the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application. *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). A reduction to practice can be done by another on behalf of the inventor. *De Solms v. Schoenwald*, 15 USPQ2d 1507, 1510 (Bd. Pat. App. & Inter. 1990). "While the filing of the original application theoretically constituted a constructive reduction to practice at the time, the subsequent abandonment of that application also resulted in an abandonment of the benefit of that filing as a constructive reduction to practice. The filing of the original application is, however, evidence of conception of the invention." *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

### CONSTRUCTIVE REDUCTION TO PRACTICE REQUIRES COMPLIANCE WITH 35 U.S.C. 112, FIRST PARAGRAPH

When a party to an interference seeks the benefit of an earlier-filed U.S. patent application, the earlier application must meet the requirements of 35 U.S.C. 120 and 35 U.S.C. 112, first paragraph for the subject matter of the count. The earlier application must meet the enablement requirement and must contain a written description of the subject matter of the interference count. *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). Proof of a constructive reduction to practice requires sufficient disclosure under the "how to use" and "how to make" requirements of 35 U.S.C. 112, first paragraph. *Kawai v. Metlesics*, 480 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973) (A constructive reduction to practice is not proven unless the specification discloses a practical utility where one would not be obvious. Prior art which disclosed an anticonvulsant compound which differed from the claimed compound only in the absence of a $-CH_2-$ group connecting two functional groups was not sufficient to establish utility of the claimed compound because the compounds were not so closely related that they could be presumed to have the same utility.). The purpose of the written description requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). The written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed. Furthermore, the written description must be sufficient, when the entire specification is considered, such that the "necessary and only reasonable construction" that would be given it by a person skilled in the art is one that clearly supports each positive limitation in the count. *Hyatt v. Boone*, 146 F.3d at 1354-55, 47 USPQ2d at 1130-1132 (Fed. Cir. 1998) (The claim could be read as describing subject matter other than that of the count and thus did not establish that the applicant was in possession of the invention of the count.). See also *Bigham v. Godtfredsen*, 857 F.2d 1415, 1417, 8 USPQ2d 1266, 1268 (Fed. Cir. 1988) ("[t]he generic term halogen comprehends a limited number of species, and ordinarily constitutes a sufficient written description of the common halogen species." except where the halogen species are patentably distinct).